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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,246	09/26/2001	F. William Daugherty	102.006	8590

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EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/963,246

Applicant(s)

DAUGHERTY ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the paper(s) filed 12/14/05.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (US6138155) in view of Marsh et al (US5848397). Davis et al teaches serving targeted third party advertisements on webpages, the ads including banners which allow the user to interact with them by way of pulldown menus, clickable buttons, hotspots, text boxes, or any number of input mechanisms [14:1-20]. Such interactions result in the presentation of information to the user. While the delivery/display/output of the requested sounds, videos, text, etc. can be taken to be fulfilled via one or more "associated information delivery processes" (such as delivery to the user's speakers and delivery to the user's screen), Davis et al does not teach fulfillment through email or telephone responses. Marsh et al teaches to provide a "specified portion" of an interactive ad banner as user-selectable in order to request more information. Further, Marsh et al teaches that the user may interact with the banner in order to forward requests for information to the email of the banner-associated vendor. Although the user's clicking that results in information displayed to the user's screen can be taken to

be a first delivery process and information delivered to a user responsive to the email request can be taken to be a second delivery process, it would have been obvious to one of ordinary skill at the time of the invention to have included such a "please contact me with more information" feature with that of Davis et al so that the vendor can send promotional/informational materials by email to the requestor. It would have been obvious to one of ordinary skill at the time of the invention to have provided multiple GUI interaction options on the banner ad, such as "learn more via telephone" and "learn more via postal mail" in addition to the "learn more via email" option, so as to provide several convenient options for delivery of information through well known communication channels. Emails sent to the user are personalized at least as far as they are personally addressed to the requestor of information. When the user interacts with the specified portion of the banner, this is taken to provide an indication of option selection. Davis et al teaches that personal information about the user is determined and employed to target ads by way of profiles and cookies. It would have been obvious to one of ordinary skill at the time of the invention to have provided a message stating that "your email has been sent to us" or "we will be emailing you the requested info soon" as a courtesy to inform the user that their request for more information has been properly submitted. Completing the steps needed to initiate the email communications is taken as inherent consent for such communications.

***Response to Arguments***

3. Applicant's arguments filed 12/14/05 have been fully considered but they are not persuasive. Applicant argues that Marsh et al teaches only a single delivery option, while the claims require plural delivery options. Marsh et al's teaching for requesting information by email would motivate one of ordinary skill to offer other well known delivery options, such as by telephone, postal mail, FAX, etc., in order to offer a variety of convenient information channels. Both Davis et al and Marsh et al teach the presence of plural interactive elements on a banner which would have been obvious methods to enable the user to interact and request information via particular delivery methods.

Applicant argues that Davis does not teach plural delivery processes. As stated above, Davis in fact could be taken to provide a first delivery process for information to a user's speakers (audio) and a second delivery process for information to a user's screen (text). Applicant also argues that Marsh et al does not teach plural delivery processes. The user's clicking that results in information displayed to the user's screen can be taken to be a first delivery process and information delivered to a user responsive to the email request can be taken to be a second delivery process.

Applicant argues that the applied art does not teach input required from the user that differs depending on which option is selected. The obviousness rejection set forth would provide for plural interaction options on the banner ad, each of which corresponds to "learn more via telephone" and "learn more via postal mail" in addition to the "learn

more via email" option. Clearly each of these requires different types of information in order for fulfillment.

Applicant argues that the only delivery option in Marsh et al is email as the system is offline. Examiner believes it would have been obvious to enable users to request information via several well known channels, each with different input mechanisms on the banner ad. The fact that one is offline and the other is online does not appear to preclude a combination of the two.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

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6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc